



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/665,303	09/19/2000	John T. Santini Jr.	17648-0014	5521

29052 7590 07/17/2003

SUTHERLAND ASBILL & BRENNAN LLP  
999 PEACHTREE STREET, N.E.  
ATLANTA, GA 30309

EXAMINER

THISSELL, JEREMY

ART UNIT PAPER NUMBER

3763

DATE MAILED: 07/17/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/665,303

Applicant(s)

SANTINI JR. ET AL.

Examiner

Jeremy T. Thissell

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 and 42-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,8-10,12,15-24,42-48,50,51 and 53-55 is/are rejected.
- 7) ☒ Claim(s) 3-7,11,13,14,25,26,49 and 51<sup>52</sup> is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

Claims 1, 2, 8-10, 12, 15-24, 42-48, 50, 51, and 53-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roth et al (WO 97/34697).

Note that this publication is written in German. Corresponding US Patent No. 6,114,658, may be used for reference as it seems to be a direct translation. The examiner has included several Babelfish translations (internet translator) of select paragraphs from the WO document, to demonstrate the correlation between the two documents. These are unofficial and imperfect, but are provided for a general idea, particularly with regard to several pertinent paragraphs. If the ensuing prosecution merits, an official translation may be obtained. However, for now, the examiner will refer to text in the US patent for purposes of convenience to both parties.

Roth teaches a multi-layer substrate having a reservoir with an encapsulated material, wherein the reservoir has a cap that is destroyed by an electrical heating element. (US '658: col. 2, lines 29-30) Roth does not explicitly state that the device contains a drug, but does teach that it is known in the art to encapsulate pharmaceuticals in this manner. (col. 1, line 10) Further it is well-known to implant such a drug-carrying microsystem into a patient. Further still, it is obvious to a skilled artisan to use any number of different drugs and controlled release patterns. Roth teaches a indicator material (aka diagnostic reagent) in the reservoir for sensing purposes.

Art Unit: 3763

**WO 97/34697, Pg 1, Para 2, 1st Sent (compare translation to US '658 Col. 1, L. 9-10)**

Auf vielen gebieten werden empfindliche materialien, z.B. chemische indikatormaterialien, katalysatoren, medikamente, eingesetzt.

**AltaVista's Babel Fish Translation Service - Microsoft Internet Explorer provided by USPTO**


File Edit View Favorites Tools Help

Back Forward Stop Refresh Home Search Favorit... History Mail Print Edit Discuss

Address <http://babelfish.altavista.com/babelfish/tr>

---

**altavista**  
Home > Tools > Babel Fish Translation > Translation Results

**Babel Fish Translation**  [Help](#)

**In English:**

On many sensitive materials, e.g. chemical indicator materials, will order catalysts, medicines, begun.

Search the web with this text

**Translate again** - Enter up to 150 words

Auf vielen gebieten werden empfindliche materialien, z.B. chemische indikatormaterialien, katalysatoren, medikamente, eingesetzt.


Use the **World Keyboard** to enter accented or Cyrillic characters.

German to English

Add **Babel Fish Translation** to your site.  
Tip: You can now follow links on translated web pages.

**Global Services**  
[Calling Cards](#)  
[World Travel](#)  
[Language Schools](#)  
[Cellular Phones](#)  
[Learn Spanish](#)  
[Mexico Travel](#)


**Babel Fish Translation Tools**  
[Translate e-mails](#)  
[Add translation to your personal or business site](#)  
[Seamless translation plugins](#) for MSOffice - Word, PowerPoint, Excel, Internet Explorer and Outlook!  
[Add translation to your site and drive traffic](#)



[Submit a Site](#) [About AltaVista](#) [Terms of Use](#) [Advertise with Us](#) [Help](#)

© 2003 AltaVista.

---

Start 

Art Unit: 3763

**Page 3, last para (compar translation to '658 col. 2, lines 21-30, sp. lines 29-30).**

Die vorliegende erfindung schafft eine vorrichtung zur gekapselten aufnahme eines materials, die einen eine ausnehmung zur aufnahme des materials aufweisenden in mikrosystemtechnik gebildeten grundkorper, eine den grundkorper überspannende, in mikrosystemtechnik oder dünnfilmtechnologie implementierte membran zur kapselung des materials in der ausnehmung des grundkörpers, und eine elektrisch betätigbare heizeinrichtung zum zerstören der membran, um das material freizulegen aufweist.

AltaVista's Babel Fish Translation Service - Microsoft Internet Explorer provided by USPTO

File Edit View Favorites Tools Help

Back Forward Stop Refresh Home Search Favorit... History Mail Print Edit Discuss

Address http://babelfish.altavista.com/babelfish/tr

**altavista**  
Home Tools > Babel Fish Translation > Translation Results

**Babel Fish Translation** Help

**In English:**

The available invention creates a device for the totally enclosed admission of a material, which exhibits a recess for the admission of the material exhibiting in micro system engineering formed more grundkorper, the more grundkorper überspannende, in micro system engineering or dünnfilmtechnologie implemented diaphragm for the packaging of the material in the recess grundkörpers, and an electrically betätigbare heating mechanism to the zerstören diaphragm, around the material freizulegen.

Search the web with this text

**Translate again** - Enter up to 150 words

Die vorliegende erfindung schafft eine vorrichtung zur gekapselten aufnahme eines materials, die einen eine ausnehmung zur aufnahme des materials aufweisenden in mikrosystemtechnik gebildeten grundkorper, eine den grundkorper überspannende, in

Use the **World Keyboard** to enter accented or Cyrillic characters

German to English Translate

Add Babel Fish Translation to your site.  
Tip: Click the "World Keyboard" link for a convenient method of entering accented or Russian characters.

**Global Services**  
Calling Cards  
World Travel  
Language Schools  
Cellular Phones  
Learn Spanish  
Mexico Travel

**Babel Fish Translation Tools**  
Translate e-mails  
Add translation to your personal or business site.  
Seamless translation plugins for MSOffice - Word, PowerPoint, Excel, Internet Explorer and Outlook  
Add translation to your site and drive traffic

**SYSTRAN**  
SYSTRAN  
SYSTRAN

Submit a Site About AltaVista Terms of Use Advertise with Us Help  
© 2003 AltaVista.

Done

Start

Art Unit: 3763

**Page 5, last line—page 6, 1<sup>st</sup> paragraph (compare transl to '658 Col. 3, lines 29-45)**

Ein gassensorbauelement, das in den Figuren 1 und 2 in seiner Gesamtheit mit dem Bezugszeichen 10 bezeichnet ist, umfasst einen Träger 1, welcher beispielsweise aus Quarz besteht, auf den die Meßelemente (z.B. Leiterbandstrukturen, MOSFET, SAW u.ä.) 2, 3 einer Interdigitalstruktur zur Kapazitäts- und/oder Widerstandsmessung mit zugehörigen Verbindungsleitungen 2b, 3b und Anschlußflächen 2a, 3a aufgebracht sind. Die Interdigitalstruktur ist mit einem Indikatormaterial 6 bedeckt. Bei dem hier gezeigten Ausführungsbeispiel des gassensorbauelementes 10 handelt es sich bei dem Indikatormaterial um 3-Amino-propyltrimethyloxysilan, welches an Luft nur eine begrenzte Lebensdauer von drei Monaten hat. Es ist deshalb erwünscht, die Indikatormaterialschicht erst kurz vor ihrem Einsatz in Kontakt mit der Umgebungsluft zu bringen, um die volle Lebensdauer der Indikatormaterialschicht zur Verfügung zu haben.

AltaVista's Babel Fish Translation Service - Microsoft Internet Explorer provided by USPTO

File Edit View Favorites Tools Help

Back Forward Stop Refresh Home Search Favorites History Mail Print Edit Discuss

Address http://babelfish.altavista.com/babelfish.htm

**altavista**  
Home Tools Babel Fish Translation Translation Results Help

**Babel Fish Translation**

In English:

A gas sensor element, das in the figures 1 and 2 in its whole with the reference symbol 10 is designated, umfasst trager 1, which consists for example of quartz, outer e (het mebelement (e.g. leiterbandstrukturen, mosfet, saw among other things) 2, 3 of an interdigital structure for the kapazitate and/or resistance test with zugehörigen leader lines 2b, 3b and Anschlußflächen 2a, 3a are applied. The interdigital structure is covered with an indicator material 6. With the export example of the element of building of gas sensors 10 shown here it concerns with the indicator material 3-amino-propyltrimethyloxysilan, which has a limited life span of three months at air only. It is therefore erwünscht to bring the indicator material layer only briefly before its employment in contact with the ambient air in order to have the full life span of the indicator material layer to the joining.

Search the web with this text

Translate again (enter up to 150 words)

Ein gassensorbauelement, das in den Figuren 1 und 2 in seiner Gesamtheit mit dem Bezugszeichen 10 bezeichnet ist, umfasst einen Träger 1, welcher beispielsweise aus Quarz besteht, auf den die Meßelemente (z.B. Leiterbandstrukturen, MOSFET, SAW u.ä.) 2, 3

Use the World Keyboard to enter accented or Cyrillic characters

German to English Translate

Add Babel Fish translation to your site

Tip: Click the "World Keyboard" link for a keyboard method of entering accented or Russian characters

Global Services  
Calling Cards  
World Travel  
Language Schools  
Cellular Phones  
Learn Spanish  
Mexico Travel

Babel Fish Translation Tools  
Translate e-mails  
Add translation to your personal or business site  
Seamless translation plugins for MSOffice - Word, PowerPoint, Excel, Internet Explorer and Outlook  
Add translation to your site and drive traffic

Submit a Site About AltaVista Terms of Use Advertising with Us Help

© 2003 AltaVista

Start [Taskbar icons] [System tray]

Art Unit: 3763

**Page 6, first full para (compar '658 col. 3, lines 46-61)**

Zum Zwecke der kapselung ist der trager 1 an seiner mit dem indikatormaterial 6 versehenen seite mit einer membranhaltestruktur 4 versehen, die bei dem hier gezeigten ausfuhrungsbeispiel aus einem siliziumwafer besteht, in dem die ausnehmung 8 durch ubliche photolithographische und atztechnische methoden eingearbeitet ist. Fur einen fachmann auf dem gebiet der mikrosystemtechnik bedarf es keener erlauterung, dab methoden zur herstellung bon einer eine haltestruktur uberspannenden membran in der mikrosystemtechnik ublich sind un dab hierbei ublicherweise eine membran 5 zunachst auf eine haltestruktur 4 durch photolithographische und atztechnische mabnahmen eingebracht wird.

**Altavista's Babel Fish Translation Service - Microsoft Internet Explorer provided by USPTO**

File Edit View Favorites Tools Help

Back Forward Stop Refresh Home Search Favorit... History Mail Print Edit Discuss

Address <http://babelfish.altavista.com/babelfish/tr>

**altavista**  
Home > Tools > Babel Fish Translation > Translation Results

**Babel Fish Translation**

In English:

For the purpose of the packaging is provided the trager 1 side provided at its with the indicator material 6 with a diaphragm holding structure 4, which consists with the driving out example shown here of a silicon wafer, in which the recess 8 by ubliche photolithographische and atztechnische methode is trained. Fur a specialist in the area of the micro system engineering requires it more keener erlauterung, dab methoden for production bon a holding structure uberspannenden diaphragm in the micro system engineering ublich is un dab here a ublicherweise diaphragm 5 zunachst on a holding structure 4 by photolithographische and atztechnische mabnahmen is brought in.

Search the web with this text

Translate again! - Enter up to 100 words

Zum Zwecke der kapselung ist der trager 1 an seiner mit dem indikatormaterial 6 versehenen seite mit einer membranhaltestruktur 4 versehen, die bei dem hier gezeigten ausfuhrungsbeispiel aus einem siliziumwafer besteht, in dem die ausnehmung 8 durch

Use the **Word Keyboard** to enter stemmed or Cyrylic characters.

German to English Translate

Add Babel Fish Translation to your site.  
Tip: You can now translate framed pages.

Global Services  
[Calling Cards](#)  
[World Travel](#)  
[Language Schools](#)  
[Cellular Phones](#)  
[Learn Spanish](#)  
[Mexico Travel](#)

Babel Fish Translation Tools  
[Translate e-mails](#)  
[Add translation to your personal or business site](#)  
[Seamless translation plugins](#) for MSOffice - Word, PowerPoint, Excel, Internet Explorer and Outlook  
[Add translation to your site and drive traffic](#)

SYSTEMS SYSTEMS

Submit a Site About Altavista Terms of Use Advertise with Us Help  
© 2003 Altavista.

Done

Start 2 3 4 5 6 7 8 9 10 11 12 13 14 15 16 17 18 19 20 21 22 23 24 25 26 27 28 29 30 31 32 33 34 35 36 37 38 39 40 41 42 43 44 45 46 47 48 49 50 51 52 53 54 55 56 57 58 59 60 61 62 63 64 65 66 67 68 69 70 71 72 73 74 75 76 77 78 79 80 81 82 83 84 85 86 87 88 89 90 91 92 93 94 95 96 97 98 99 100 101 102 103 104 105 106 107 108 109 110 111 112 113 114 115 116 117 118 119 120 121 122 123 124 125 126 127 128 129 130 131 132 133 134 135 136 137 138 139 140 141 142 143 144 145 146 147 148 149 150 151 152 153 154 155 156 157 158 159 160 161 162 163 164 165 166 167 168 169 170 171 172 173 174 175 176 177 178 179 180 181 182 183 184 185 186 187 188 189 190 191 192 193 194 195 196 197 198 199 200 201 202 203 204 205 206 207 208 209 210 211 212 213 214 215 216 217 218 219 220 221 222 223 224 225 226 227 228 229 230 231 232 233 234 235 236 237 238 239 240 241 242 243 244 245 246 247 248 249 250 251 252 253 254 255 256 257 258 259 260 261 262 263 264 265 266 267 268 269 270 271 272 273 274 275 276 277 278 279 280 281 282 283 284 285 286 287 288 289 290 291 292 293 294 295 296 297 298 299 300 301 302 303 304 305 306 307 308 309 310 311 312 313 314 315 316 317 318 319 320 321 322 323 324 325 326 327 328 329 330 331 332 333 334 335 336 337 338 339 340 341 342 343 344 345 346 347 348 349 350 351 352 353 354 355 356 357 358 359 360 361 362 363 364 365 366 367 368 369 370 371 372 373 374 375 376 377 378 379 380 381 382 383 384 385 386 387 388 389 390 391 392 393 394 395 396 397 398 399 400 401 402 403 404 405 406 407 408 409 410 411 412 413 414 415 416 417 418 419 420 421 422 423 424 425 426 427 428 429 430 431 432 433 434 435 436 437 438 439 440 441 442 443 444 445 446 447 448 449 450 451 452 453 454 455 456 457 458 459 460 461 462 463 464 465 466 467 468 469 470 471 472 473 474 475 476 477 478 479 480 481 482 483 484 485 486 487 488 489 490 491 492 493 494 495 496 497 498 499 500 501 502 503 504 505 506 507 508 509 510 511 512 513 514 515 516 517 518 519 520 521 522 523 524 525 526 527 528 529 530 531 532 533 534 535 536 537 538 539 540 541 542 543 544 545 546 547 548 549 550 551 552 553 554 555 556 557 558 559 560 561 562 563 564 565 566 567 568 569 570 571 572 573 574 575 576 577 578 579 580 581 582 583 584 585 586 587 588 589 590 591 592 593 594 595 596 597 598 599 600 601 602 603 604 605 606 607 608 609 610 611 612 613 614 615 616 617 618 619 620 621 622 623 624 625 626 627 628 629 630 631 632 633 634 635 636 637 638 639 640 641 642 643 644 645 646 647 648 649 650 651 652 653 654 655 656 657 658 659 660 661 662 663 664 665 666 667 668 669 670 671 672 673 674 675 676 677 678 679 680 681 682 683 684 685 686 687 688 689 690 691 692 693 694 695 696 697 698 699 700 701 702 703 704 705 706 707 708 709 710 711 712 713 714 715 716 717 718 719 720 721 722 723 724 725 726 727 728 729 730 731 732 733 734 735 736 737 738 739 740 741 742 743 744 745 746 747 748 749 750 751 752 753 754 755 756 757 758 759 760 761 762 763 764 765 766 767 768 769 770 771 772 773 774 775 776 777 778 779 780 781 782 783 784 785 786 787 788 789 790 791 792 793 794 795 796 797 798 799 800 801 802 803 804 805 806 807 808 809 810 811 812 813 814 815 816 817 818 819 820 821 822 823 824 825 826 827 828 829 830 831 832 833 834 835 836 837 838 839 840 841 842 843 844 845 846 847 848 849 850 851 852 853 854 855 856 857 858 859 860 861 862 863 864 865 866 867 868 869 870 871 872 873 874 875 876 877 878 879 880 881 882 883 884 885 886 887 888 889 890 891 892 893 894 895 896 897 898 899 900 901 902 903 904 905 906 907 908 909 910 911 912 913 914 915 916 917 918 919 920 921 922 923 924 925 926 927 928 929 930 931 932 933 934 935 936 937 938 939 940 941 942 943 944 945 946 947 948 949 950 951 952 953 954 955 956 957 958 959 960 961 962 963 964 965 966 967 968 969 970 971 972 973 974 975 976 977 978 979 980 981 982 983 984 985 986 987 988 989 990 991 992 993 994 995 996 997 998 999 1000

Art Unit: 3763

***Allowable Subject Matter***

Claims 3-7, 11, 13, 14, 25, 26, 49, and <sup>52</sup>51 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

This action is being made NON-FINAL view of new grounds of rejection.



Art Unit: 3763

***Contacts***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy T. Thissell whose telephone number is (703) 305-5261. The examiner can normally be reached on 8:30-7:00 Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached at (703) 308-3552. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

jt

July 9, 2003



BRIAN L. CASLER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700